

REMARKS

The present application has been reviewed in light of the Office Action dated April 18, 2003. Claims 29-46 are presented for examination, of which Claims 29, 34, 39, and 46 are in independent form. Favorable reconsideration is requested.

The Office Action states that Claims 29-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,765,170 (Morikawa) in view of U.S. Patent No. 6,453,327 (Nielsen). Applicant respectfully traverses the rejections and submits that independent Claims 29, 34, 39, and 46, together with the claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

An aspect of the present invention set forth in independent Claim 29 is directed to a communication device that includes reception means, acquisition means, a memory, judgment means, and warning means. The reception means sends a transmit request to an e-mail server and receives an e-mail transmitted from the e-mail server in response to the transmit request. The acquisition means acquires size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server. The memory stores e-mails received by the reception means.

The judgment means judges whether or not it is possible to receive at the communication device an e-mail stored in the e-mail server, according to the size information and a storable capacity of the memory. If the judgment means judges that an e-mail to the communication device cannot be received, the warning means visually outputs warning information indicating that the e-mail stored in the e-mail server cannot be received.

One of the features of Claim 29 is that if the judgment means judges that the size of the e-mail exceeds the storable capacity of the memory then the e-mail cannot be received and a visible warning is outputted by the warning means, so that a user may be notified that the communication device is unable to receive the e-mail.

Morikawa relates to an electronic mail processing system, in which folders are used for storing received electronic mail. A management device of the system classifies a data file written in the received electronic mail and selects a folder for storing the data file. (See the abstract and column 2, lines 33-41.)

Nielsen relates to a mail system with a junk e-mail screening feature for identifying and discarding junk e-mail. A subset of the members of a trusted group of recipients determines for the rest of the trusted group whether an e-mail should be considered junk. That is, if a sufficient number of the trusted group of recipients classifies the e-mail as junk, then the e-mail is automatically removed (deleted) from the mail system so that the other members of the trusted group who have not yet viewed the e-mail are not annoyed by it. (See column 6, lines 53-67.)

Applicant submits that Claim 29 is patentable over a combination of Morikawa and Nielsen et al., assuming such combination is even permissible, for at least the reason that neither reference is understood to teach or suggest a communication device that includes "judgment means for judging whether it is possible or not to receive at said communication device an e-mail stored in the e-mail server, according to the size information and a storable capacity of said memory," and "warning means for visually outputting warning information

indicating that an e-mail to said communication device, stored in the e-mail server, cannot be received, as a result of a judgment by said judgment means," as recited in Claim 29.

The Office Action alleges that the claimed judgment means is disclosed in Morikawa at column 2, line 34, to column 3, line 55; column 6, line 2, to column 7, line 37; and column 8, lines 15-67; and in Figs. 1 and 2. However, none of the cited portions of Morikawa discusses or even suggests judging whether it is possible to receive an e-mail *based on the size of the e-mail and a storable capacity of a memory*, as claimed in Claim 29.

The Office Action concedes that Morikawa does not disclose the warning means of Claim 29, but alleges that Nielsen remedies this deficiency of Morikawa. That is, it is asserted in the Office Action that the warning feature of Claim 29 is disclosed in Nielsen at column 6, lines 53-67; column 7, line 21, to column 8, line 42; and column 10, lines 15-67; and in Figs. 1 and 3. However, a careful reading of the cited portions of Nielsen reveals that the Nielsen mail system relies on users (the members of the trusted group of recipients) to make a determination as to whether a received e-mail is junk, and then returning a "Junk Mail Report" to a server if it is decided that the e-mail is junk. Therefore, Nielsen teaches that the e-mail *necessarily* is received by the mail system, because the users need to view the e-mail before they can make their determinations. (See column 7, line 42, to column 8, line 12.)

Nothing in Nielsen is understood to suggest that the users make a determination as to whether it is possible to receive an e-mail based on a size of the e-mail and a storable capacity of a memory. Instead, Nielsen is understood to teach that users first receive an e-mail and then make a determination as to whether the e-mail is junk based on the *contents of*

the received e-mail. In contrast, the communication device of Claim 29 judges whether an e-mail can be received based on the e-mail's size and the storable capacity of the memory.

Applicant submits that merely adding the Nielsen junk e-mail screening feature to the Morikawa system would not result in or even suggest the warning feature of Claim 29. More specifically, as discussed above, Nielsen merely teaches a way to screen received e-mail for junk, which is automatically deleted when enough users decide it is junk. Including that feature in the Morikawa system would merely produce a modified Morikawa system having the added feature of removing junk e-mail that users have already received, after some of the users view the e-mail and indicate that it is junk. Such combination would not suggest to one of ordinary skill in the relevant art a feature of warning users when e-mail *cannot be received*.

In fact, by teaching that e-mail must first be received before it can be determined to be junk, Nielsen is believed to *teach away* from judging whether it is possible to receive e-mail.

Accordingly, Applicant submits that Claim 29 is believed to be patentable over Morikawa and Nielsen, considered separately or in combination, and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a). Independent Claims 34, 39, and 46 include judgment and warning features similar to those discussed above. Therefore, those claims also are believed to be patentable for at least the same reasons as discussed above.

The other rejected claims in this application depend from one or another of the independent claims discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the

invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

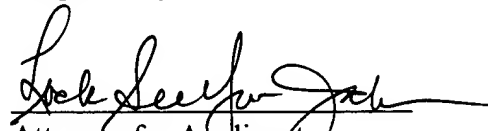
In view of the foregoing remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office Action is deemed necessary for the present Response. If, however, such a petition is required to make this Response timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 06-1205.

CONCLUSION

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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